Remarks

FIGS. 1-3, 5-7, 9 and 12 disclose radially extending members having a front side and a back side, and a collar extending rearwardly behind the back side. The front side provides finger grips for Applicant's syringes. The rearwardly extending collar provides longitudinal separation between the back side of the radially extending members and the open back end of the collar. Independent claims 29, 37, 45, 110 and 117, and dependent claims 83, 102-104, 116 and 118-119 are all amended herein to recite that structure, which is not disclosed in any of Tsao '018, Pressly et al. '629 or Caselli '710 (discussed by Examiner but not applied).

Claim 54 is further amended to recite grounding by a barrier limiting forward motion of the needle holder prior to or during retraction. Similar language already appearing in claims 58 and 81 is also amended to recite "prior to or during retraction" as suggested by Examiner. Claims 54, 58 and 81 patentably distinguish over Caselli '710 because, *inter alia,* Caselli fails to disclose a barrier limiting forward motion of the needle holder prior to or during retraction, thereby avoiding the infliction of pain to a patient that will be caused, for example, with the device disclosed by Caselli '710. These claims and related dependent claims are also amended to more clearly recite "retraction spring" in view of the structure disclosed by Caselli '710 that utilizes two springs, one of which purportedly holds the "pliers" in position against the body—except when, as noted at Col. 4, lines 46-52, the pliers separate from seat 23 as the plunger advances prior to retraction.

Claim 113 is amended to recite structure further distinguishing the invention over structure disclosed in Tsao '018, and is supported for example by disclosure appearing in FIGS. 1 and 2, and in related portions of Applicant's specification.

This paper supplements and Applicant incorporates by reference herein, and also relies upon, the Remarks presented in the Amendment and Response filed on February 23, 2007, in support of the claim language as amended in that paper that is carried forward in the claims as presented herein, also including but not limited to the amendments and remarks directed to claims in the February amendment that are not fully addressed herein. All pending dependent claims are also believed to patentably

distinguish over Tsao '018, Pressly et al. '629 and Caselli '710 by reason of the amendments to the independent claims as presented in this response.

Additionally, Applicant notes in this supplemental response that both Tsao '018 and Caselli '710, for example, are both believed to be inoperative as disclosed because they fail to take into consideration scientific principles that prevent their operation in the manner purportedly shown. For example, FIG. 3 of Caselli '710 shows gasket element 24 in a configuration that is substantially different from that shown in FIG. 7 with no observed explanation regarding the structural differences, although the Brief Description of the Drawings suggests that FIGS. 3 and 7 are depicting the same syringe. Applicant believes that Caselli's syringe cannot not function as described if all the parts are shown consistently in all figures. Caselli '710 shows one structure that will seal during injection and a different structure that will initiate retraction, but they are not the same. In Tsao '018, the structure shown in the drawings cannot function as described. In order to function as intended, each syringe that is capable of retracting a needle must first be able to draw an injection from a conventional rubber-sealed vial and then maintain a fluid seal within the variable volume chamber during injection without "blowing out" the syringe as taught by Applicant in the instant disclosure. Once the injection has been completed, the thumb force required to initiate retraction must be one that can reasonably be applied by health care workers, which is typically less than the force required for injection. Thus, for example, a syringe that will retract under a thumb force of 12 pounds must typically avoid retraction under a thumb force of 18 pounds during injection without leaking past the seal. How that is achieved is not obvious, as evidenced by the many "paper patents" depicting syringes that cannot be made or used as described.

As noted in Applicant's declaration filed with the previous response, years of experimentation, development, time and expense were required to produce a workable syringe having a retractable needle. The structural elements recited in Applicant's claims are those elements that facilitate the operation of a safe and effective device that can be manufactured, even at relatively high speeds and relatively low cost. Although inoperability may not always negate anticipation as to certain structures, those (like Applicant) who persevere and invent ways to solve problems previously unsolved by

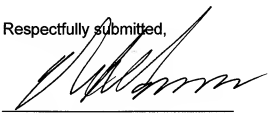
others and make recognized commercial products, and who also disclose information to the public to permit the production of effective, manufacturable and saleable devices, should not be deprived of patents based upon the disclosures of others that are inoperative and cannot, according to the laws of statics, dynamics, mechanics and fluid hydraulics provide the purported solutions upon which those prior patents were predicated.

In light of the recently decided Federal Circuit decision in *Hakim v. Cannon Avent Group*, ___ F.3d ___, 2007 WL 542697 (Fed. Cir. Feb. 23, 2007), Applicant also hereby expressly disclaims for purposes of this application and any resultant patent any and all arguments that were made in one or more of the parent applications to distinguish the prior art, including but not limited to the arguments advanced in application no. 08/438,954, issued as U.S. 5,578,011, the arguments advanced in application no. 08/537,242, issued as U.S. 5,632,733, and the arguments advanced in application no. 08/843,050, issued as U.S. 6,090,077. To the extent it is considered necessary or desirable, the examiner should reconsider the art that was cited against the claims in the parent applications. The claims of the current application are directed to different aspects of the disclosed invention and therefore are distinct from the prior art for reasons that may differ from the arguments advanced in the parent applications. The combinations of structural elements that formed the basis of the arguments in the parent applications are not present in all the claims of the current application, thereby clearly rendering the prior arguments inapplicable to such claims. Further, it is respectfully asserted that the reasons that the currently amended claims should be considered patentable over the prior art are completely set forth in the prosecution history of this application. Therefore, there is no need to rely on any argument advanced in a parent application with respect to different claims to support the patentability of the claims in the current application.

It is not believed that any fee is due in connection with this Supplemental Amendment and Response, but please charge any additional fee that may be required or credit any overpayment to Deposit Account No. 12-1781 of Locke Liddell & Sapp, LLP.

All pending claims are believed to be in condition for allowance, and Applicant respectfully requests that the rejections of record be withdrawn and the application allowed.

Respectfully submitted,



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